



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/086,138	05/28/98	JAFFE	R ETLIP002US

021121
OPPEDAHL AND LARSON LLP
P O BOX 5270
FRISCO CO 80443-5270

HM12/0927

EXAMINER
GITOMER, R

ART UNIT
1623

DATE MAILED:

09/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/086,138

Applicant(s)

Jaffe

Examiner

Ralph Gitomer

Group Art Unit

1623



☒ Responsive to communication(s) filed on Sep 20, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The amendment received 9/20/99 has been entered and claims 1-15 are currently pending in this application. In view of the helpful comments and arguments presented, new rejections are presented and previous rejections are hereby withdrawn. This Office action is made non-final.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-17 of prior U.S. Patent No. 5,387,508. This is a double patenting rejection.

The claims of '508 do not include nor exclude any dilution or concentration of the sample prior to testing.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe.

Jaffe (5,387,508) by the present inventor entitled "Detection of Cytotoxic Agents Using Tetramitus Rostratus" teaches in claim 3 first paragraph, the sample may be a liquid, gaseous or solid material. Various types of whole effluent samples are taught.

It is noted the present specification on page 2 last paragraph discusses '508 where '508 does not disclose a WET test in which all of the potentially toxic substances from the sample are evaluated in a natural combination. See in '508 Example 5 in column 6 where a WET sample is tested. See the claims.

The claims differ from Jaffe in that they recite other flagellates than those taught by Jaffe.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ flagellates other than T. Rostratus because in view of the teachings of Jaffe, one would have a high expectation of success in employing

any known flagellate with the requisite qualities taught in the present specification. It is noted that the present specification teaches specific methods and examples only for *T. rostratus*.

5 Further, the present claims recite the sample is combined with the culture directly.

In '508 column 3 first paragraph, samples may be concentrated, or, in the case of solids, suspended in a liquid, prior to testing. It would appear the sensitivity of the test would be dependent upon the concentration of the cytotoxic substances and to dilute or concentrate samples to make them more suitable for a given test is well known in this art and taught by '508, see column 7 Table 2.

15 Applicant's arguments filed 9/20/99 have been fully considered but they are not persuasive.

Applicant argues that the present claims require the whole effluent sample is combined directly with the culture which means there is no requirement for concentration of the sample prior to combining it with the culture.

20 It is the examiner's position that the specification and claims of '508 consider the feature of concentrating the sample optional, see discussion presented above.

Serial No. 09/086,138
Art Unit 1623

-5-

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm. The examiner can also be reached on alternate Mondays. If
10 attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode, can be reached on (703) 308-4311. The fax phone number for this Art Unit is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose
15 telephone number is (703) 308-1234.



Ralph Gitomer
Primary Examiner
Group 1623

RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200